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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/074,786

02/12/2002

Norishige Morimoto

JP920000444US1

7209

7590 04/04/2007
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT.
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EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/074,786

Applicant(s)

MORIMOTO ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 6-23, 25-30, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 24 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1, 2, 6-23, 25-30, 32 and 33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 have been examined.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 22, 23, 29, 30, drawn to content tracking, classified in class 705, subclass 14.
 - II. Claims 3-5, 24, 31, drawn to identifier registration, classified in class 705, subclass 14.
 - III. Claims 6, 7, 25, drawn to database searches, classified in class 705, subclass 14.
 - IV. Claims 8-10, 26, 32, drawn to database searches, classified in class 705, subclass 14.
 - V. Claims 11-13, 27, drawn to content reproduction, classified in class 705, subclass 14.
 - VI. Claims 14-15, 28, 33, drawn to an end user reproducing content, classified in class 705, subclass 14.
 - VII. Claims 16-21, drawn to reproduction detection, classified in class 705, subclass 14

Inventions I -VII are based on different sets of Independent claims. Each Group involves a different, distinct set of features as stated in the claims Groupings above.

Because these inventions are distinct for the reasons given above and the search required

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for Group I is different than the search required for Groups II, etc., restriction for examination purposes as indicated is proper.

During a telephone conversation with Robert Trepp at (914)945-3147 on 2/1/2007 a provisional election was made with traverse to prosecute the invention of Group II, claims 3-5, 24, 31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1, 2, 6-23, 25-30, 32, 33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3-5, 24, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerace (5,848,396).

Claims 3, 24, 31: Gerace discloses a content registration/management system comprising:

content registration request reception means, for receiving a request for content registration from a content provider that provides content (Figures 5a-5d; col 3, lines 4-20);

identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said

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identifier to a content provider (col 17, lines 52-col 18, line 10; col 6, line 57-col 7, line 23);
and

a content ledger database, for storing information related to said identifier provided said content provider (col 33, lines 35-col 34, line 27).

As noted in the citations above, Gerace discloses that ad packages are identified, ad series are identified. Gerace also discloses that individual ads are placed in a table (Fig. 5d). Gerace also discloses that individual ads are tracked, performance data for each ad is tracked and reported, and the analysis of the performance of individual ads (col 18, lines 10-26; col 18, lines 50-col 19, line 5; col 5, lines 25-40; claims 9 and 13). Therefore, individual ads are also given identifiers. Identifiers would be necessary for each ad in order to store, track, report, compare, analyze the ads and the ad performance.

Also, Examiner notes that Gerace discloses that advertisements are a form of content or agate information (col 2, lines 60-67).

Claim 4: Gerace discloses the content registration/management system according to claim 3, further comprising:

identifier reception means, for receiving from a user terminal an identifier provided for said user terminal (col 6, line 57-col 7, line 24); and

content reproduction information collection means, for collecting, based on the reception of said identifier, information related to the reproduction of content (col 6, line 57-col 7, line 24; col 33, lines 35-col 34, line 27).

Claim 5: Gerace discloses the content registration/management system according to claim 4, further comprising:

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an advertisement ledger database for registering a list of contents that can be used as advertisement media (Figures 2, 3a); and

notification means for searching said advertisement ledger database based on said received identifier, and for transmitting an advertisement distribution request to an advertiser (Figures 2, 3a; col 20, lines 9-30; col 16, lines 45-55; col 33, lines 35-col 34, line 27).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) McElfresh (2003/0149937) discloses tracking individual advertisements which are given identifiers (Abstract; fig 3a, 3b);

b) Merriman (5,948,061) discloses tracking individual advertisements which are given identifiers (Fig 3b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
2/1/2007